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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/101,341	07/08/1998	KENT MALMGREN	000500-128	9545
21839	7590	05/19/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			WHITE, EVERETT NMN	
POST OFFICE BOX 1404			ART UNIT	
ALEXANDRIA, VA 22313-1404			PAPER NUMBER	
			1623	
DATE MAILED: 05/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/101,341

Applicant(s)

MALMGREN ET AL.

Examiner

EVERETT WHITE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The amendment filed January 15, 2004 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
 - (A) Claims 17 and 18 have been previously canceled;
 - (B) Comments regarding Office Action have been provided drawn to:
 - (i) 102(e) rejection of Claims 13-16, which has been maintained for the reasons of record; The 102(e) rejection of Claims 1, 3-5, 7-12, 19 and 20 has been withdrawn;
 - (ii) 103(a) rejection, which has been maintained for the reasons of record.
2. Claims 1-16 and 19-21 are pending in the case.
3. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. Claims 13-16 stand rejected under 35 U.S.C. 102(e) as being anticipated by Qin et al (US Patent No. 5,550,189) for the reasons set forth on pages 5 and 6 of the Office Action mailed July 15, 2003.
5. Applicant's arguments filed January 15, 2004 have been fully considered but they are not persuasive. Applicants argue against the rejection of Claims 13-16 on the ground that the Qin et al patent does not set forth the process as claimed for preparing the polysaccharide. This argument is not persuasive since the instant claims are drawn to a polysaccharide fiber product, not a process for producing the polysaccharide fiber. Process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), *supra*; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Applicants argue that the process of the instant claims provides certain advantageous structural properties such as cross-linking of the surface of the formed polysaccharide fibers. This argument is not persuasive since cross-linking of the surface is a fundamental concept

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for ionically cross-linked material. See column 12, lines 6-8 of the Qin et al patent, wherein Qin et al teaches that the crosslinking may be carried out with ionic bonding, which clearly shows that the polysaccharide fiber of the Qin et al patent anticipates the polysaccharide fiber of the instant claims. Accordingly, the rejection of Claims 13-16 under 35 U.S.C. 102(e) as being anticipated by the Qin et al patent is maintained for the reasons of record.

Claim Rejections - 35 USC § 103

6. Claims 1-12 and 19-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Qin et al (US Patent No. 5,550,189) in view of Coull et al (EP 410,323) for the reasons set forth on pages 6-8 of the Office Action mailed July 15, 2003.
7. Applicant's arguments filed January 15, 2004 have been fully considered but they are not persuasive. Applicants argue against the rejection of Claims 1-12 and 19-21 on the ground that the Qin et al patent does not disclose spraying a solution into a bath which contains a water-miscible organic solvent and a cross-linker, wherein the solution is formed by dissolving a polysaccharide in water, as set forth in instant Claim 1. This argument is not persuasive because the Qin et al patent does set forth a method that involves forming a mixture of a modified polysaccharide, water and a crosslinking agent, and recovering the modified polysaccharide from the mixture. In the 4th paragraph of column 13, Qin explains that the order of mixing the carboxyalkyl polysaccharide, water, and crosslinking agent is not critical when a crosslinking agent is used. In this paragraph, Qin et al teaches that it may be beneficial, when using certain crosslinking agents, to first add the carboxyalkyl polysaccharide and water and then to add the crosslinking agent to the mixture. Qin et al discloses that the recovery of the carboxyalkyl polysaccharide from the mixture may be carried out by various methods that include precipitation. In column 15, 3rd paragraph, Qin et al discloses that precipitation of the carboxyalkyl polysaccharide out of the mixture may be carried out using a precipitating agent, such as methanol, ethanol, or acetone. The methanol, ethanol, and acetone are within the scope of the water-miscible organic solvent

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disclosed in the instant claims. Qin et al further discloses that the recovered carboxyalkyl polysaccharide may be in the form of a fiber (see column 15, line 39-41), which embraces the production of the polysaccharide fibers of the instant claims. Even though the Qin et al patent sets forth the same components used to prepare a polysaccharide fiber as set forth in the instant claims, Applicants appear to argue that by spraying a polysaccharide and water solution into an organic solvent and cross-linker containing bath some how make the instantly claimed process patentable. In order for this procedure to have patentable weight, the polysaccharide fiber, which is produced, would have to be a new product. There is no evidence of record that the polysaccharide fiber produced by the instantly claimed process is a new or improved product. The Coull et al patent is only cited to show that the use of polyvinylamine as a cross-linker with a cellulose product is well known in the art. In view of the arguments presented above and previously of record, the rejection of Claims 1-12 and 19-21 under 35 U.S.C. 103(a) as being unpatentable over the Qin et al patent in view of the Coull et al patent is maintained for the reasons of record.

Summary

8. Claims 1-16 and 19-21 are rejected.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Examiner's Telephone Number, Fax Number, and Other Information

10. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (571) 272-0660. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



E. White



James O. Wilson
Supervisory Primary Examiner
Technology Center 1600